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**OFFICE OF PETITIONS**

In re Application of	:	
Theidig, et al.	:	
Application No. 09/931,606	:	DECISION ON PETITION
Filing Date: 16 August, 2001	:	
Attorney Docket No. 64251-030	:	

This is a decision on the petition filed on 11 March, 2005, alleging unintentional delay under 37 C.F.R. §1.137(b).

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**NOTE:**

The address of record is different from that on the instant petition. If Petitioner desires to receive future correspondence regarding this application at the latter address, the appropriate Notice of Change of Address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

## BACKGROUND

The record indicates:

- Petitioner failed to reply timely and properly to the final Office action mailed on 6 January, 2004, with reply due absent extension of time on or before 6 April, 2004;
- on 5 April, 2004, Petitioner filed as a reply an after-final amendment, which Examiner found was not a proper reply (in that it did not place the application in condition for allowance<sup>1</sup>), and on 11 February, 2005, the Examiner mailed an Advisory Action;
- the application went abandoned after midnight 6 April, 2004;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;
- the instant petition was filed on 11 March, 2005, and was accompanied by a request for continued examination (RCE) with fee and submission under 37 C.F.R. §1.114, and Petitioner alleges unintentional delay and makes the required statement in support thereof.

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

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<sup>1</sup> A proper reply is a an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or a CPA or RCE (with fee and submission). (See: MPEP §711.03(c).)

<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.<sup>3</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>)

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

Petitioner has satisfied the petition, fee, reply and statement/showing requirements of the regulation.

The record (including the petition filed on 11 March, 2005) does not necessitate a finding that the delay between midnight 6 April, 2004 (the date of abandonment), and 11 March, 2005 (the date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Applicants and their Counsel Robert C. Haldiman (Reg. No. 45,437) when accepting Petitioner's representation that the delay in filing the response was unintentional.<sup>8</sup>

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<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>8</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) hereby is **granted**, and fees charged as authorized.

The instant application is released to Technology Center 3700 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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cc:

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